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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/711,823	10/07/2004	Burkhard Pollak	LUKP:123US	5822
24041 7590 07/12/2007 SIMPSON & SIMPSON, PLLC 5555 MAIN STREET WILLIAMSVILLE, NY 14221-5406			EXAMINER PILKINGTON, JAMES	
			ART UNIT 3682	PAPER NUMBER
			MAIL DATE 07/12/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	10/711,823	POLLAK ET AL.	
	Examiner	Art Unit	
	James Pilkington	3682	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 01 May 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Continued Prosecution Application*

The request filed on 5/1/07 for a Continued Examination (RCE) is accepted and a RCE has been established. An action on the RCE follows.

### *Claim Rejections - 35 USC § 112*

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1 and 3-9 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. How the shift finger and disengaging elements *operate the gearshift rails* (clm 1 line 3) is critical or essential to the practice of the invention which is not disclosed in either the specification, the claims or the drawings. How do the shift finger and disengaging members operate the gearshift rails? How does the shift finger shift? How do the disengaging members disengage? What do the shift finger and disengaging member communicate with on the shift rails to move them? See paragraph 7 below.

### *Claim Rejections - 35 USC § 103*

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

Art Unit: 3682

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1 and 3-9, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshimura, USP 4,911,031, in view of Jerwick, USP 6,082,215.

Re clm 1, Yoshimura discloses a gearbox actuator comprising:

- A drive unit (1 or 4)
- A single selector shaft (22)
- Wherein said single selector shaft comprises a shift finger (23) and disengaging elements (sides of 2 and 23, one side is always disengaged from 31-34 when the other side is engaged/pushing the rail forward or back words), said single selector shaft (22) is driven by said drive unit (1 or 4)
- The shift finger (23) and disengaging elements are arranged to operate shift rails (35-38)

Yoshimura does not disclose that the selector shaft and the drive unit are arranged in a gearbox actuator housing and that there is a bearing arrangement formed by protruding rods operatively arranged to support the gearshift rails.

Jerwick teaches that a selector shaft (34) and a drive unit (36) are arranged in a gearbox actuator housing (64/50) and a bearing arrangement formed of protruding rods (80 and 82) operatively arranged to support the gearshift rails for the purpose of providing a shift assembly that can be conveniently manufactured and repairable while

Art Unit: 3682

still maintaining a reliable and durable transmission having an acceptable shift feel (C1/L60-63).

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify the teachings of Yoshimura and provide for the selector shaft and a drive unit to be arranged in a gearbox actuator housing and a bearing arrangement formed of protruding rods operatively arranged to support the gearshift rails, as taught by Jerwick, for the purpose of providing a shift assembly that can be conveniently manufactured and repairable while still maintaining a reliable and durable transmission having an acceptable shift feel.

Re clm 3, Yoshimura in view of Jerwick discloses that the housing comprises an attachment part (base 50 of Jerwick) operatively arranged to be attached to a gear housing of a gearbox (screwed on, see Figures 2 and 5 of Jerwick) where in the protruding rods protrude through an opening or recess in the gear housing into the gearbox actuator housing (see Figures 5, 6A and 6B of Jerwick).

Re clms 5 and 7, the resulting device of Yoshimura in view of Jerwick would further comprise first and second upper protruding rods and first and second lower protruding rods (each rail of Yoshimura requires a bearing support disclosed by Jerwick), said first and second upper protruding rods arranged opposite/symmetrically opposite each other with respect to the selector shaft, and said first and second lower protruding rods arranged opposite/symmetrically opposite each other with respect to the selector shaft.

Re clm 6, Jewick discloses that two protruding rods are provided (80 and 82 of Jewick).

Re clm 8, Yoshimura in view of Jewick discloses all the claimed subject matter above as applied to claim 1.

Yoshimura in view of Jewick, as applied to claim 1, does not disclose that the protruding rods have guide shoe parts at their ends resting against the gearshift rails.

Jewick teaches that the protruding rods (80 and 82) have guide shoe parts (90 and 92) at their ends (90 and 92 are arranged at the ends of the rods 80 and 82) resting against the gearshift rail (the rail 96/inside of shoe 90 and 92 rest against each other) for the purpose of a support that enables for the rail to rotate and translate (C4/L10-13).

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify the teachings of Yoshimura in view of Jewick and provide for the protruding rods to have guide shoe parts at their ends resting against the gearshift rail, as taught by Jewick, for the purpose of a support that enables for the rail to rotate and translate.

Cls 4 and 9 are product-by-process claims and product-by-process claims are not limited to the manipulations of the recited steps, only the structure implied by the steps.

### ***Response to Arguments***

5. Applicant's arguments filed 5/01/07 have been fully considered but they are not persuasive.

6. Applicant's arguments with respect to the rejection made under 35 U.S.C. 112 1<sup>st</sup> paragraph have been fully considered but they are not persuasive. The applicant continues to rely on Norum, USP 7,093,511, as supporting references for the operation of the shift finger and disengaging member. The applicant cites Figure 22, 23a and 23b and columns 26 line 42 and columns 29 line 16 as providing support. The applicant then goes on to cite reference characters that are part of a different embodiment that is not similar to that of the instant applicant. Norum discloses that characters 1711 and 1713, which appear to be the same as what the applicant refers to as the engagement and disengagement elements, are first and secondary actuation elements. The examiner still does not understand how the disengaging elements disengage the shift rail, it appears that these would act as engagement elements as well.

7. The applicant argues that Jerwick fails to teach a device having a single selector shaft arranged in a gearbox actuator housing and a bearing arrangements operatively arranged to support gearshift rails.

The examiner disagrees and directs the applicant to Figure 2 where it shows that the gearbox actuator housing is made of a bottom half 62 and a top half 60 including a bearing arrangement for the shift rails (80 and 82). The examiner also notes that the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the



Art Unit: 3682

test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

In this case Jerwick does indeed suggest arranging the device of Yoshimura in a gearbox actuator housing and providing a bearing arrangement operatively arranged to support gearshift rails.

8. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the drive unit being a brushless motor) are not recited in the rejected claim(s).

Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

9. The applicant argues that the bearing arrangement recited in claim 1 is different than that of Jerwick.

The examiner disagrees and argues that claim 1 only recites "a bearing arrangement operatively arranged to support gearshift rails...said bearing arrangement is formed by protruding rods operatively arranged to support the gearshift rails." This recitation only requires a bearing arrangement formed of protruding rods which must be capable of supporting gearshift rails. This Jerwick clearly teaches by using protrusions 80 and 82. The claim does not set forth any structure difference between the instant application and Jerwick.



### ***Conclusion***

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Pilkington whose telephone number is (571) 272-5052. The examiner can normally be reached on Monday-Friday 8:00AM-4:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Ridley can be reached on (571) 272-6917. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

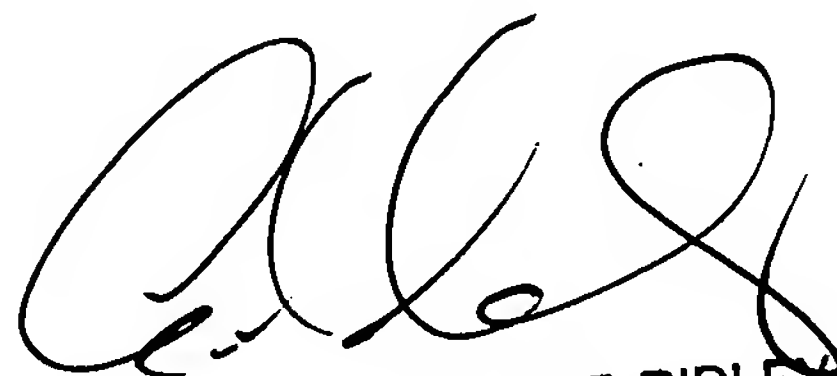
Art Unit: 3682

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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7/2/07



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